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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL RALEY, THOMAS DEMARTINI,
CHARLES P. GILLIAM, MANUEL HAM, GUILLERMO LAO,
and BIJAN TADAYON

Appeal 2015-000259¹
Application 10/388,161²
Technology Center 3600

Before ANTON W. FETTING, BIBHU R. MOHANTY, and
NINA L. MEDLOCK, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–14 and 31. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellants' Appeal Brief ("App. Br.," filed June 4, 2014) and Reply Brief ("Reply Br.," filed October 1, 2014), and the Examiner's Answer ("Ans.," mailed August 1, 2014) and Final Office Action ("Final Act.," mailed November 8, 2013).

² Appellants identify ContentGuard Holdings, Inc. as the real party in interest. App. Br. 1.

CLAIMED INVENTION

Appellants' claimed invention "generally relates to controlling use of content, or other items, through rights expressions associated with the content or other items, and more particularly to a system and method for profiling rights expressions" (Spec. ¶ 2).

Claim 1, reproduced below, is the sole independent claim and representative of the subject matter on appeal:

1. A computer-implemented method executed by one or more computing devices for creating an encoded rights expression for association with an item of digital content for use in a digital rights management system for controlling use of the item of digital content in accordance with the encoded rights expression, the method comprising:

specifying, by at least one of the one or more computing devices, a raw rights expression, the raw rights expression indicating a manner of use of an item of digital content, the raw rights expression including at least one rights expression language element, the at least one rights expression language element including a variable field and expressing a corresponding value for the variable field;

generating, by at least one of the one or more computing devices, a profile of the raw rights expression by removing, from the raw rights expression, the value for the variable field of the at least one rights expression language element, the profile including the raw rights expression including the variable field without the corresponding value;

generating, by at least one of the one or more computing devices, an identification for the profile; and

creating, by at least one of the one or more computing devices, an encoded rights expression by combining the identification for the profile and the value for the variable field.

REJECTIONS

Claims 1–14 and 31 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1–14 and 31 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

ANALYSIS

Written Description

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact and is assessed on a case-by-case basis. *See, e.g., Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991)). The disclosure, as originally filed, need not literally describe the claimed subject matter (i.e., using the same terms or *in haec verba*) in order to satisfy the written description requirement. But the Specification must convey with reasonable clarity to those skilled in the art that, as of the filing date, Appellants were in possession of the claimed invention. *See id.*

Here, the Examiner bases the written description rejection on the alleged failure of claim 1 to “recite limitations as to how the functions” of ‘specifying, by at least one of the one or more computing devices, a raw rights expression . . . field’ or ‘generating, by at least one of the one or more computing devices, a profile of the raw rights expression . . . value’” are performed, and on the alleged failure of Appellants’ Specification to “identify a way of performing the claimed functions such as with a specific type of microprocessor or specific algorithm” (Final Act. 4; *see also* Ans. 3–

4). The Examiner, thus, seemingly confuses the enablement provision of 35 U.S.C. § 112, first paragraph, with the written description requirement, which is a separate requirement.

To satisfy the written description requirement, Appellants need only demonstrate original descriptive support in the Specification for the subject matter recited in claim 1. The Examiner has not established that the Specification, as filed, lacks the requisite descriptive support. As such, the Examiner has not established a *prima facie* case of unpatentability.

Therefore, we do not sustain the Examiner's rejection of claims 1–14 and 31 under 35 U.S.C. § 112, first paragraph.³

Non-Statutory Subject Matter

Appellants argue claims 1–14 and 31 as a group (Reply Br. 1–4). We select independent claim 1 as representative. The remaining claims stand or fall with claim 1. *See* 37 C.F.R. §41.37(c)(1)(iv).

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Labs.*,

³ We note for the record that the Board's earlier January 9, 2013 Decision in application Serial No. 10/388,161 (affirming the Examiner's rejection of claims 15–30 and 32 under 35 U.S.C. § 112, second paragraph, as indefinite) is not relevant to the written description rejection here of claims 1–14 and 31 under 35 U.S.C. § 112, first paragraph.

Inc., 132 S. Ct. 1289, 1300 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of these concepts.” *Alice Corp.*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” *id.*, e.g., to an abstract idea. If the claims are not directed to an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Alice Corp.*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1297).

The Court acknowledged in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 132 S. Ct. at 1293. We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.

Here, in rejecting the claims under 35 U.S.C. § 101, the Examiner found that claims 1–14 and 31 are directed to the abstract idea of licensing digital content; that the claims do not add any meaningful limitation beyond linking the use of the abstract idea to a particular technological environment; and that the claims require no more than a generic computer performing generic computer functions that are well-understood, routine, and conventional activities previously known in the industry (Ans. 3).

Appellants argue that limitations of claim 1 recite a number of physical steps performed by one or more computing devices and that the

claims, therefore, are not directed to an abstract idea but rather to a physical process (Reply Br. 2). Yet there is no indication in claim 1 that any specialized hardware is required. And “after *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible. The bare fact that a computer exists in the physical rather than purely conceptual realm is beside the point.”

DDR Holdings, LLC v. Hotels.com, L.P., 773 F.3d 1245, 1256 (Fed. Cir. 2014) (internal citations and quotation marks omitted).

Appellants also charge that the Examiner’s assertion that the claims are “generic computer functions that are well-understood, routine, and conventional activities previously known in the industry’ is completely unsubstantiated, unsupported by any evidence or argument, and wholly incorrect” (Reply Br. 3). But Appellants present no evidence to establish otherwise. And to the extent Appellants contend that the Examiner is required to provide such evidence, the law is clear that there is no such requirement. *See, e.g., In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (holding that the PTO carries its procedural burden of establishing a prima facie case when its rejection satisfies the notice requirement of 35 U.S.C. § 132).

Appellants further contend that claim 1 is patent-eligible because the claimed method is tied to a particular machine or apparatus and transforms a particular article into a different state or thing (Reply Br. 4; *see also* App. Br. 9–11). Yet claim 1 is not tied to any particular novel machine or apparatus; instead, the claim merely recites a general purpose computer, i.e., “one or more computing devices.”

Moreover, although the Supreme Court noted in *Bilski v. Kappos* that the machine-or-transformation test is a “useful and important clue” for determining patent eligibility, 130 S. Ct. 3218, 3227, the Court, in *Mayo*, emphasized that satisfying the machine-or-transformation test, by itself, is not sufficient to render a claim patent-eligible, as not all transformations or machine implementations infuse an otherwise ineligible claim with an “inventive concept.” See *Mayo*, 132 S. Ct. at 1301 (“[S]imply implementing a mathematical principle on a physical machine, namely a computer, [i]s not a patentable application of that principle.”) (describing *Gottschalk v. Benson*, 409 U.S. 63, 64 (1972)). And, as described above, it could not be clearer from *Alice* that the recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.

We also cannot agree with Appellants that claim 1 satisfies the transformation prong of the machine-or-transformation test. The method, as claimed, involves “generating . . . a profile of the raw rights expression by removing, from the raw rights expression, the value for the variable field of the at least one rights expression language element.” But this generating step effects no meaningful transformation. Instead, it merely creates a profile, i.e., a separate entity, which is the raw rights expression including the variable field without the corresponding value.

We are not persuaded for the reasons set forth above that the Examiner erred in rejecting claim 1 as directed to non-statutory subject matter. Therefore, we sustain the Examiner’s rejection of claim 1 under 35 U.S.C. § 101. We also sustain the rejection of dependent claims 2–14 and 31, which fall with claim 1.

DECISION

The Examiner's rejection of claims 1–14 and 31 under 35 U.S.C. § 112, first paragraph, is reversed.

The Examiner's rejection of claims 1–14 and 31 under 35 U.S.C. § 101 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED